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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,011	06/24/2003	Jay L. Gainsboro	18279-08041	5720
758	7590	06/20/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			FOSTER, ROLAND G	
		ART UNIT	PAPER NUMBER	
		2645		
DATE MAILED: 06/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/606,011	GAINSBORO, JAY L.
	Examiner	Art Unit
	Roland G. Foster	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 January 2005.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 52-71 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 52-71 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/6/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments were considered persuasive (see page 6 of the amendment, filed on January 25, 2005). Thus, the previously indicated allowable subject matter and the double patenting rejection have been withdrawn. Upon further consideration, a restriction requirement is necessary due to the highly divergent subject matter between two subcombinations within the claims. Further, the a double-patenting rejection is set forth below for one of the subcombinations that is merely broader than or insubstantially different from the claims of the parent applications.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 52-58 and 66-71 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 19, and 20 of parent U.S. Patent No. 5,926,533 and claims 1-27 of parent U.S. Patent No. 6,611,583. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

claims in the continuation are broader than the claims in the parent. See In re Van Ornum and Stang, 214 USPQT61, where broad claims in continuation applications are rejected as obvious double patenting over previously patented narrow claims. For example, claim 52 of the present invention (continuing application) is the same as same as claim 1 of the parent 6,611,583 patent except that the comparing step in the present invention compares "ring tones" while the parent patent compares one of "ring tones" plus other types of tones. Therefore, claim 52 of the present invention is broader than claim 1 of the parent 6,611,583 patent. In another example, claim 52 of the present invention is substantively similar to claim 3 and 19 (a call progress tone is recognized to include ring tones).

***Election/Restrictions***

Claims 52-71 are directed to inventions that are distinct for the following reasons.

**Patentable Distinctness**

***Description of the Separate Inventions***

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Invention 1: claims 52-58 and 66-71, drawn to a system for detecting a call bridging attempt by detecting ring-tones.

Invention 2: claims 59-65, drawn to a method for controlling institutional communications by recording conversations and detecting call bridging attempts by detecting a

variety of different tone types. Significantly, the conversation recording feature involves a detailed recitation of voice recognition features and functions (e.g., claim 65).

*The Subcombinations Are Patentably Distinct From Each Other*

Inventions 1 and 2 are related as subcombinations disclosed as usable together in a single system where institutional communications are controlled and monitored.

Subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention 1 has separate utility as a system that can prevent call-bridging attempts by detecting ring tones. Invention 2 has separate utility has a system that can record a institutional caller's voice and then compare that voice to a voice sample in order to identify the institutional caller. See MPEP § 806.05(d).

Administrative Burden

*Separate Classification and Different Field of Search*

Inventions 1 and 2 have separate classifications and fields of search as discussed below.

Invention 1 includes classification in class 379, subclass 257, call progress tones. The field of search for Invention 1 would concentrate on systems that monitor call progress tones.

Invention 2 includes classification in class 379, subclass 88.92, voice verification using voice recognition. The field of search for Invention 2 would significantly diverge the field of

search for Invention 1 because Invention 2 would include various fields directed to speech and voice recognition in class 379, subclasses 88+ (telephonic voice/speech recognition) and class 704, subclass 231+ (general voice/speech recognition).

*Separate Status in the Art*

A separate field of search (as discussed above) also shows a separate status in the art (MPEP § 808.02). Thus, Inventions 1 and 2 also have separate status in the art.

*Conclusion – Administrative Burden*

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one Invention is not required for the other Inventions for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter for the reasons given above, restriction for examination purposes as indicated is proper.

Requirement for a Complete Response

Applicant is advised that the reply to this requirement to be complete must include an election of one of the Inventions 1 or 2 to be examined even if the requirement is traversed (37 CFR 1.143).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster  
Primary Patent Examiner  
June 13, 2005